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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,108	07/28/2003	Kazuo Koyama	03338CIP/HG	6344

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/629,108

Applicant(s)

KOYAMA ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 46-118 is/are pending in the application.
- 4a) Of the above claim(s) 46-92 in part, 93-118 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 69, 72, 80 and 85-92 is/are rejected.
- 7) ☐ Claim(s) 46-68, 70, 71, 73-79 and 81-84 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

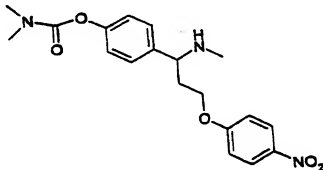
- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Claims 1-118 are pending in this application.

Claims 93-118 are drawn to non-elected invention.

### **RESTRICTION REQUIREMENT**

The election of group I, claims 46-92, in the paper filed 12/20/04 is hereby acknowledged. Claims 46-92 are being examined in part subject to the election made by applicant. Applicant elected the following compound:



Wherein in formula 1, R1 is dimethylamino, X1 and X2 are each oxygen, Ra and R2 are each H, R3 is methyl, A is  $-C_2H_4-$ , E is oxygen and Arom is phenyl substituted at position 4 by  $NO_2$ . The compound is elected with traversal on the basis that the requirement fails to conform to the 3<sup>rd</sup> paragraph of MPEP 803.02. This is not persuasive because the requirement did conform to the 3<sup>rd</sup> paragraph of MPEP 803.02. However, claims 46-92, as written, are improper Markush claims.

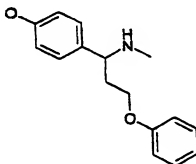
The restriction is still deemed proper and therefore made FINAL.

### **Status of Claims**

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar

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thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound (or set of compounds), but may also include additional compounds, which fall in related subclasses. Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification results in the following:



Wherein, in formula 1, R1 and X1 are as defined in the claims, X2 is oxygen, Ra is as defined in the claims but would not combine together with R2, R2 is H, R3 is alkyl, A is  $-C_2H_4-$ , E is oxygen and Arom is optionally substituted phenyl. As a result of the election and the corresponding scope of the invention identified above, the remaining subject matter of claims 46-92 are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to non-elected subject matters. The withdrawn compounds are patentably distinct from the elected invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the elected invention, would not render obvious the non-elected subject matter.

Examination has been carried out as set forth under MPEP 803.02 and applicant should note that the search cannot be "extended unnecessarily to cover all non-elected species." Such

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would be a serious burden on the Examiner. The examined species are within the limitation of the generic claims as set forth in MPEP 806.04(d).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 69,72, 80, 85-92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 69 and 80 are duplicates of 68 and 79 respectively. Claim 72 is improperly depend from claims 46-52 for failure to limit the scopes of the independent claims. Therefore, claims 69, 72 and 80 are indefinite. By deleting claims 69,72, 80, the rejection would be overcome. The term "containing" in line 1 of claims 85-92 renders the claims indefinite. By replacing the term with "comprising" the rejection would be overcome.

***Objection***

Claims 46-92 are objected to for containing non-elected subject matter. To place the application in condition for allowance, applicant must amend the claims as set forth above under Status of Claims.

***Rejoinder***

Claims 93-101 would be rejoined following allowability of the compound and composition claims. Claims 102-118 would be rejoined if the utilities are limited to only "treating" since not all the cited diseases are preventable, particularly Alzheimer disease in claims 111-118. By

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deleting "preventing" from claims 102-118 they would be rejoined following allowability of the compound and composition claims.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

February 16, 2005